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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,981	07/22/2003	Thomas Zdeblick	MSDI-168/PC566.02	6600
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KRIEG DEVAULT LLP ONE INDIANA SQUARE, SUITE 2800 INDIANAPOLIS, IN 46204-2709			EXAMINER PREBILIC, PAUL B	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/624,981

Applicant(s)

ZDEBLICK ET AL.

Examiner

Paul B. Prebilit

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,61,65-76,79-87,90-98 and 101-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,61,65-76,79-87,90-98 and 101-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/26/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2007 has been entered.

Information Disclosure Statement

The information disclosure statement filed November 26, 2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. No copies of the foreign patents were found in the file so the information disclosure statement was deemed incomplete.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 79, and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language "said outer wall" lacks

antecedent basis and it is unclear what element the language "projecting around said engaging surface" is referring.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 66-68, and 72-73 are rejected under 35 U.S.C. 102(e) as being anticipated by Branemark (US 6,015,937). Branemark anticipates the claim language where:

- the occlusion body as claimed is the blanking element (6a) of Branemark (see Figure 1
- the outer surface as claimed is the surface that reference number (6a) points
- the inner surface as claimed is the opposite surface to the outer surface
- the engaging surface as claimed is the end surface between the inner and outer surfaces that are inherently capable of contacting an inner surface of slot (5a)
- the anchor as claimed is the tab that engages the slot (5a)
- the lip as claimed is the lip.

The tabs must be resiliently deflectable to be able to function properly and engage the slots in slot (5a).

With regard to claim 2, the flange as claimed is the other lip on the other anchor of Branemark.

With regard to claim 68, the Applicant is directed to column 6, lines 11-14 of Branemark.

Claims 1, 2, 66-69, 73, 74, 87, 90-94, and 96 are rejected under 35 U.S.C. 102(e) as being anticipated by Chervitz et al (US 5,766,250). Chervitz anticipates the claim language wherein:

- the inner surface as claimed is the upper face (29) of Chervitz (see Figure 1)
- the engaging surface as claimed is the end surface (27b)
- the outer surface as claimed is the undersurface (28)
- the anchor as claimed is the post (30b).

The anchor can be made of resilient material; see column 7, lines 59-67.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Branemark (6.015,937) or Chervitz et al (US 5,766,250) in view of Biedermann et al (US 5,702,461) or Ray et al (WO 91/06261). Branemark or Chervitz fails to disclose apertures in the cap as claimed. However, Biedermann (see Figures 3 and 5) or Ray (see Figure 1) teaches that it was known to put apertures in similar devices that are inherently capable of allowing ingrowth and protein ingress due to their macroscopic size. Therefore, it is the Examiner's position that it would have been obvious to put apertures in the occlusion body of either Branemark or Chervitz for the same reasons that Biedermann or Ray does the same and in order to better promote fusion.

Claims 65, 75, 79-81, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branemark (6.015,937) in view of Biedermann et al (US 5,702,461) or Ray et al (WO 91/06261). Branemark fails to make the outer walls with flat surfaces. However, Biedermann or Ray teaches that it was known to make similar devices with flat outer surfaces. Therefore, it is the Examiner's position that it would have been obvious to make the outer surfaces of Branemark at least partially flat for the same reasons that Biedermann or Ray does the same.

Claims 75, 79-83, and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chervitz et al (US 5,766,250) in view of Biedermann et al (US 5,702,461) or Ray et al (WO 91/06261). Chervitz fails to make the outer walls with flat surfaces. However, Biedermann or Ray teaches that it was known to make similar devices with flat outer surfaces. Therefore, it is the Examiner's position that it would

have been obvious to make the outer surfaces of Chervitz at least partially flat for the same reasons that Biedermann or Ray does the same.

Claims 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branemark (US 6,015,937) or Chervitz et al (US 5,766,250) in view of Michelson (US 6,605,089). Branemark or Chervitz fail to disclose the use of a porous material to make the body or plate as claimed. However, Michelson teaches that it was known to make similar devices in the art of porous materials; see claim 49 thereof. Therefore, it is the Examiner's position that it would have been obvious to make the occlusion body porous for the same reasons that Michelson did the same or in order to promote ingrowth or ongrowth.

Claims 76, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branemark, Biedermann, and Ray as applied to claim 65 above, and further in view of Michelson (US 6,605,089). Branemark fails to teach a porous surface on the occlusion body as claimed. However, Michelson teaches that it was known to make similar devices in the art of porous materials; see claim 49 thereof. Therefore, it is the Examiner's position that it would have been obvious to make the occlusion body porous for the same reasons that Michelson did the same or in order to promote ingrowth or ongrowth.

Claims 95, 98, 101, 102, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chervitz et al (US 5,766,250) in view of Michelson (US 6,605,089). Chervitz fails to disclose the use of a porous surface on the occlusion body thereof. However, Michelson teaches that it was known to make similar devices in the art of

porous materials; see claim 49 thereof. Therefore, it is the Examiner's position that it would have been obvious to make the occlusion body porous for the same reasons that Michelson did the same or in order to promote ingrowth or ongrowth.

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chervitz and Michelson as applied to claim 103 above, and further in view of Branemark (US 6,015,937). Chervitz fails to teach a curved profile on the lip. However, Branemark teaches that the same was known. Therefore, it is the Examiner's position that it would have been obvious to make the lip slightly curved for the same reason that Branemark does the same or in order to prevent shape edges acting as a cutting edge on tissue.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
Art Unit 3774